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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,178	07/02/2001	Mark Matteo	SIMP-0001	2922
23550	7590	01/20/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FL ALBANY, NY 12207			HARBECK, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/897,178	MATTEO, MARK
	Examiner Timothy M. Harbeck	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/02/2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/02/2001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Purcell et al (hereinafter Purcell, US PAT 6,196,447 B1).

**Re Claim 1:** Purcell discloses an envelope with outside coupon flap comprising

- A first redeemable instrument printed on an exterior side of a sealed envelope, wherein the first redeemable instrument includes a first redeemable value (Column 1, lines 34-37, Figure 1).
- A second redeemable instrument enclosed within the sealed envelope, wherein the second redeemable instrument includes a second redeemable value (Column 1, lines 12-15). Purcell discloses that payments are often enclosed in the envelope, said payment being a second instrument (i.e. check) with a second redeemable value (i.e. value of the invoice or bill).

**Re Claim 6:** Purcell further discloses wherein the sealed envelope includes at least one removable perforated tab (Fig 1, 19,20,21).

**Re Claims 11 and 14:** Further gift certificate system would have been obvious from previously rejected third party payment system claims 1 and 6 respectively and are therefore rejected using the same art and rationale.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7, 10, 12, 13, 15, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell.

**Re Claim 2:** Purcell discloses the claimed system supra but does not explicitly disclose wherein the first redeemable instrument comprises a gift certificate and the first redeemable value provides an amount of the gift certificate. However Purcell does disclose that the first redeemable instrument is a coupon, which provides the same function as a gift certificate. Both represent a value for the ultimate user that has been accounted for previously at no cost to said ultimate user. Coupons often provide a discount, of a certain amount as well, weather it be for a specific product or a variety of products. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include a gift certificate with a redeemable value to the disclosure of Purcell, since a gift certificate and a coupon perform similar functions, and many times can be substitutes for one another.

**Re Claim 3:** Purcell discloses the claimed system supra but does not explicitly disclose wherein the second redeemable instrument comprises a band check and the

second redeemable value provides an amount of the bank check. However, Purcell does disclose that the instrument disclosed may be included in a first mailed envelope for commercial activities such as the payment of bills, the ordering of merchandise, or the like (Column 1, lines 12-15). It was well known in the art at the time of invention for people to enclose a bank check with a specific amount for the payment of bills or the ordering of merchandise and therefore it would have been obvious to anyone skilled in the ordinary art to conclude that said second instrument could be a bank check.

**Re Claim 4:** Purcell discloses the claimed system supra and while not explicitly disclosing the step wherein the amount of the gift certificate is greater than the amount of the bank check it would have been obvious to anyone skilled in the ordinary art at the time of invention to include this feature to the disclosure of Purcell since some merchandise that is orderable, can be very cheap and it would be very likely that in some instances the enclosed bank check will be of a lesser amount than the gift certificate or coupon on the exterior of the envelope. This could be the case regardless of the value of the coupon since certain merchandise can be purchased at such small amounts.

**Re Claim 5:** Purcell discloses the claimed system supra but does not explicitly disclose wherein the gift certificate is redeemable by at least one participating merchant, and the bank check is valid only for the at least one participating merchant. However it would have been obvious to anyone skilled in the ordinary art at the time of invention for the gift certificate to be redeemable by at least one merchant, or else the gift certificate is worthless. Furthermore, it would have been obvious for the bank check to be valid

only for that participating merchant since the gift certificate or coupon attached would be for a discount associated with the merchant for which the payment is intended. If the enclosed bank check were valid for a merchant that was not associated with the gift certificate on the exterior, then the merchant would be under no obligation to honor said gift certificate, again making it worthless.

**Re Claim 7:** Purcell discloses the claimed system supra and but does not explicitly disclosing the step wherein a premature removal of the at least one perforated tab voids the first redeemable instrument. However it was well known in the art at the time of invention that there are many ways in which promotional coupons or gift certificates such as the ones disclosed by Purcell could be voided if certain procedures were not followed. For instance, while Purcell discloses that the coupon is detachable, there may be reasons why the customer would detach the coupon to purposely void it. Say the promotion is attached to a cellular phone bill and if the coupon is sent, in tact with the bill, then the customer will receive one month of free service. Most individuals would welcome this discount, however if a customer wants to either discontinue or switch services they would want to remove said coupon, thus voiding the offer. This is an obvious and well-known method in the art wherein persons have to take additional steps to void coupons or gift certificates and would have been obvious to include in the Purcell disclosure.

**Re Claim 10:** Purcell discloses the claimed method supra but does not explicitly disclose wherein the sealed envelope includes a listing of participating merchants on a second exterior side. However it was well known in the art at the time of invention and

would have been obvious to provide such a feature because gift certificates often involve multiple merchants and a customer would need to know which merchants they can contact in order to redeem the value of said gift certificate. If a listing were not present, the customer could attempt to redeem the coupon at a non-participating merchant and be rejected and therefore wasting time.

**Re Claims 12, 13, 15 and 18:** Further gift certificate system would have been obvious from previously rejected third party payment system claims 4, 5, 7 and 10 respectively and are therefore rejected using the same art and rationale.

**Re Claim 19:** Purcell discloses an envelope with outside coupon flap comprising

- Issuing a redeemable instrument to a first party for a predetermined amount (Column 1, lines 40-44)
- Printed on an exterior side (See Figure 1)
- Wherein the sealed envelope contains a negotiable instrument (i.e. a bank check), (Column 1, lines 12-15)

Purcell does not explicitly disclose

- Wherein the redeemable instrument is provided by a third party
- Guaranteeing that the redeemable instrument can be redeemed in exchange for a consideration provided by a second party equal to the predetermined amount and;
- Reimbursing the second party by allowing the second party to remove the negotiable instrument from the sealed envelope, wherein the negotiable instrument is payable to the second party for a payable amount

Art Unit: 3628

However these features involving third parties, among others, were well known in the art at the time invention and would have been obvious to include in any coupon or gift certificate redemption system. For example cell phone manufactures often have agreements with service providers to provide discounts to customers whom elect their type of phone. While these parties are separate and distinct, the synergy that is present draws them into potential agreements. For example the phone service company may send a bill to a customer with a coupon attached for a discount on a certain type of phone from a particular manufacturer. The manufacturer, in exchange for offering the coupon with the bill, would offer some type of benefit to the service provider, such as a royalty payment. In this manner, all three parties benefit, the customer gets a discounted phone, the manufacturer gets a new client and the service provider sees additional revenue. This type of three party exchange happens often and would have been obvious to anyone skilled in the ordinary art should the situation present itself in order to benefit all parties. Furthermore the step of guaranteeing the instrument would be obvious because some type of agreement between the parties would need to be in place in order for the one party to first present a coupon with the other parties invoice or product.

**Re Claim 20:** Purcell discloses the claimed method supra but does not explicitly disclose the step of obtaining agreement between the second and third party regarding the payable amount of the negotiable instrument. However this step would have been obvious to anyone skilled in the ordinary art in order to assure that all parties fulfill their obligations. If there were no agreement in place, any one of the parties could default in

Art Unit: 3628

the system, thus rendering it useless and providing no compensatory benefit to the other parties. Without a guarantee, most business would find the proposition to risky as they would not want to be associated with system that fails to provide the benefit intended.

**Re Claim 21:** Purcell discloses the claimed method but does not explicitly disclose the step of allowing the redeemable instrument to be gifted from the first party to a giftee and allowing the giftee to redeem the redeemable instrument with the second party. However this step was well known and would have been obvious to anyone skilled in the ordinary art at the time of invention. In keeping with the cell phone example, a customer who receives the coupon may not be in a position to take advantage of the offer. Perhaps they already have the same phone for which the coupon is for or perhaps they had just recently purchased a different phone before becoming aware of the offer. The manufacturer and service provider though, not wanting to lose out on potential benefit would want to allow the user to gift the instrument to a friend who could use it, but would not otherwise be aware of the offer. If the instrument was not allowed to be gifted, both the manufacturer and service provider would lose out on potential benefits. It then follows that the friends, should they be inclined to redeem the instrument, be allowed to do so with the second party, in a sense taking over for the friend who gifted the benefit.

**Re Claim 22:** Purcell discloses the claimed method supra but does not explicitly disclose wherein the first instrument comprises a gift certificate and the negotiable instrument comprises a bank check. However Purcell does disclose that the

redeemable instrument is a coupon, which provides the same function as a gift certificate. Both represent a value for the ultimate user that has been accounted for previously at no cost to said ultimate user. Coupons often provide a discount, of a certain amount as well, whether it be for a specific product or a variety of products. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include a gift certificate with a redeemable value to the disclosure of Purcell, since a gift certificate and a coupon perform similar functions, and many times can be substitutes for one another. Furthermore, Purcell does disclose that the negotiable instrument may be included in a first mailed envelope for commercial activities such as the payment of bills, the ordering of merchandise, or the like (Column 1, lines 12-15). It was well known in the art at the time of invention for people to enclose a bank check with a specific amount for the payment of bills or the ordering of merchandise and therefore it would have been obvious to anyone skilled in the ordinary art to conclude that said second instrument could be a bank check.

**Re Claim 23:** Purcell discloses the claimed method supra but does not explicitly disclose wherein the first party comprises a customer and the second party comprises a participating merchant. However it was well known in the art at the time of invention that this is how coupon or gift certificate methods operate. A customer redeems an instrument at a merchant whom has previously agreed to accept this instrument. A person who redeems the instrument is in fact, by definition, a customer and a second party who redeems the instrument must then be participating or else they would not honor said instrument.

**Re Claim 24:** Further method claim would have been obvious from previously rejected method claim 5 and is therefore rejected using the same art and rationale.

Claims 8-9 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Purcell in view of Feng et al (US 2002/0093191 A1).

**Re Claim 8:** Purcell discloses the claimed system supra but does not disclose the step wherein the second redeemable instrument is attached to an interior of the sealed envelope. Feng discloses a single sheet mailer having a gift certificate or the like wherein a redeemable instrument is attached to an interior of a sealed envelope (See abstract). The gift certificate is in fact folded into a part of the envelope, and is situated on the interior. It would have been obvious to anyone skilled in the ordinary art at the time of invention to include this feature to the disclosure of Purcell in order to keep the redeemable instrument situated on the inside of the envelope and also allow for easier mass production of the assembly as a single unit as opposed to multiple units.

**Re Claim 9:** Purcell in view of Feng discloses the claimed system supra and Feng further discloses wherein the second redeemable instrument includes a perforated edge for the removal from the interior of the sealed envelope (Figure 7).

**Re Claims 16 and 17:** Further gift certificate system would have been obvious from previously rejected third party payment system claims 8 and 9 respectively and are therefore rejected using the same art and rationale.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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